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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,548	09/17/2001	Akira Kibashi	JP920000200US1	9802

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Intellectual Property Law
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EXAMINER

PATEL, GAUTAM

ART UNIT	PAPER NUMBER
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2655

DATE MAILED: 06/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/955,548

Applicant(s)

KIBASHI ET AL.

Examiner

Gautam R. Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 4-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-3 are pending for the examination. Claims 4-14 are removed as non-elected claims.

Election/Restriction

2. Claims 4-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Groups B-E. Election was made without traverse in Paper No. 6.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119(a)-(d), which papers have been placed of record in the file.

NOTES & REMARKS

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. For example page 10, last line reads "process in necessary", ay be it should read "process is necessary". Applicant's cooperation is requested in correcting any errors of which Applicant may become aware in the specification.

Drawings/Objection

5. The drawings are objected for following reasons:

Figure(s) 3 is/are not designated by a legend such as "Prior Art". The legend is necessary in order to clarify what applicant's invention is (see MPEP § 608.02g).

Applicant is required to submit a proposed drawing correction in response to this Office Action. Any proposal by the applicant for amendment of the drawings to cure defects must consist of following:

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of

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the changes made must be presented either in the drawing amendments, or remarks, section of the amendment, and may be ***accompanied by a marked-up copy of one or more of the figures being amended, with annotations.*** Any replacement drawing sheet ***must be identified in the top margin as "Replacement Sheet"*** and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. ***Any marked-up (annotated) copy showing changes must be labeled "Annotated Marked-up Drawings" and accompany the replacement sheet in the amendment (e.g., as an appendix).***

Correction is required.

Specification

6. The disclosure is objected for following reasons.

The title of the invention is neither precise nor descriptive. A new title is required which should include, using twenty words or fewer, claimed features that differentiate the invention from the Prior Art. It is recommended that the title should reflect the gist of or the improvement of the present invention.

Correction is required.

Claim Rejections - 35 U.S.C. § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1 and 3 are rejected under 35 U.S.C. § 102(e) as being anticipated by Arai et al., US. patent 6,169,710 (hereafter Arai).

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As to claim 1, Arai discloses the invention as claimed [see Figs. 1-3] including a reader/writer, a determiner, a retry commander and a data overwrite logic, comprising:

a reader/writer [fig. 1, unit 3] for reading and writing data from/to a storage medium [optical disc] [col. 2, lines 28-37];

a determiner [fig. 1, unit 3] for determining whether data can be successfully read by said reader/writer;

a retry commander [fig. 1, unit 3] for commanding said reader/writer to retry to read the data if said determiner determines that the data read operation can be unsuccessful; and

a data overwrite logic [fig. 1, unit 3] for overwriting the storage medium with the read data if a command has been issued a predetermined number of times or more by said retry commander when the data read operation is determined to be successful by said determiner [col. 2, line 28 to col. 3, line 23].

Claim Rejections - 35 U.S.C. § 103

8. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 2-3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Arai as applied to claim 1 above in view of Kulakowski et al., US. patent 5,233,584 (hereafter Kulakowski).

Arai discloses all of the above elements, including a data saving logic [fig. 1 unit 3] for saving data to be overwritten in a memory [fig.1, unit 4] [col. 2, line 28 to col. 3, line 23]. Arai does not specifically disclose type of the memory section where data is saved, such as nonvolatile memory or ROM.

However, use and application of nonvolatile memory or ROM is very well known in the art for very long time and almost all newer system has these on the disc to save ID, control functions etc.

Also Kulakowski clearly discloses that it well known in the art to store the data to be rerecorded [overwritten] in a ROM [col. 2, lines 53-58 and col. 4, line 59 to col. 5, line 34].

Both Arai and Kulakowski are interested in improving the overwrite mechanism of the disk both shows ID fields [pointers] for the new data to be written, thus defining location information.

One of ordinary skill in the art at the time of invention would have realized that the system of Arai would have been sensitive to noise that is associated with RAM type memory and it may destroy sensitive data while trying to write another data on the disk, and it would be useful to have a portion of the memory allocated as nonvolatile memory to save important and/or old data.

Therefore, it would have been obvious to have used a ROM [or nonvolatile memory in the system of Arai as taught by Kulakowski because one would be motivated to prevent destruction of important data in the system of Arai and provide better reliability for over all operation of the system.

10. The aforementioned claim 3, recites the following elements inter, alia disclosed in Arai:

a pointer information changer [ID changer, fig. 1, unit 3] for changing the pointer information which points to the storage location of the data to be read on the storage

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medium after the data was saved by said data saving logic or overwritten by said data overwrite logic [col. 3, line 55 to col. 4, line 20].

Other prior art cited

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Yamada (US. patent 6,014,754) "Signal recording and regenerating ..".
- b. Anzai et al. (US. patent 6,697,314) "In formation reproducing ..".
- c. Kulakowski et al. (US. patent 4,813,011) "Data processing ..".
- d. Estakhri et al. (US. patent 6,034,897) "Space management ..".
- e. Shirane (US. patent 6,198,709) "Signal recording/reproducing ..".
- f. Barr et al. (US. patent 5,909,334) "Verifying write operation ..".
- g. Shannon (US. patent 5,568,608) "Method for protecting data ..".

Contact Information

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam R. Patel whose telephone number is (703) 308-7940. The examiner can normally be reached on Monday through Thursday from 7:30 to 6.

The appropriate fax number for the organization (Group 2650) where this application or proceeding is assigned is (703) 872-9314.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Doris To can be reached on (703) 305-4827.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-4700 or the group Customer Service section whose telephone number is (703) 306-0377.

Gautam R. Patel
Primary Examiner
Group Art Unit 2655



June 6, 2004

**GAUTAM R. PATEL
PRIMARY EXAMINER**